

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 9, 11 and 75-88 are pending in the application, with claim 9 being the sole independent claim. Claims 1-8, 10 and 12-74 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. New claims 75-88 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

I. Election/Restriction

In reply to the restriction requirement set forth in the Office Action at pages 2-5, Applicants have elected to prosecute the invention of Group IV, represented by claims 9-11.

This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. This election is made without traverse.

II. Support for Amended and New Claims

Support for amended claim 9 can be found throughout the specification, for example, at paragraph 159 (pages 61-63), at paragraph 166 (page 65), and at paragraph 228 (pages 89-90).

Support for new claims 75-82 can be found throughout the specification, for example, at paragraph 62 (pages 28-29).

Support for new claims 83-88 can be found throughout the specification, for example, at paragraph 190 (page 73).

III. Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 10 and 11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. *See* Paper No. 11, page 5. This rejection is based on the recitation of the phrase "said modified ribonucleotide" in claim 10. According to the Office Action, there is insufficient antecedent basis for this limitation in the claim. *See* Paper No. 11, page 6.

Claim 10 has been cancelled, thereby rendering this rejection moot.

IV. Claim Rejections Under 35 U.S.C. § 102

Claims 9-11 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,440,723 to Dale ("Dale"). *See* Paper No. 11, page 6. Applicants respectfully traverse this rejection and submit that the currently presented claims are not anticipated by Dale.

The currently presented claims are directed to compositions comprising one or more target nucleic acid molecules and at least one oligonucleotide. At least a portion of the oligonucleotide is capable of hybridizing with at least a portion of the target nucleic acid molecule. The oligonucleotide comprises a modified nucleotide at or near its 3'-terminal

nucleotide. In addition, the modified nucleotide is not complementary to the corresponding nucleotide of the target nucleic acid molecule, thereby rendering the oligonucleotide less extendable in an extension or amplification reaction than if the modified nucleotide were complementary to the corresponding nucleotide of said target nucleic acid molecule.

Dale relates to arrays of oligonucleotides that have been modified so that the oligonucleotide is "substantially resistant to acid degradation." *See Dale* at column 10, line 63, through column 11, line 2. Dale, however, does not describe a composition comprising an oligonucleotide and a target nucleic acid molecule, wherein the oligonucleotide comprises a modified nucleotide at or near its 3'-terminal nucleotide, and wherein the modified nucleotide is not complementary to the corresponding nucleotide of the target nucleic acid molecule, thereby rendering the oligonucleotide less extendable in an extension or amplification reaction than if the modified nucleotide were complementary to the corresponding nucleotide of said target nucleic acid molecule.

An anticipation rejection under 35 USC § 102 requires a showing that each element of a claim is found in a single reference, practice, or device. *See In re Donohue*, 766 F.2d 531, 226 USPQ 619, 621 (Fed. Cir. 1985). Since not every element of the currently presented claims is described in Dale, Dale cannot and does not anticipate the currently presented claims. Applicants respectfully request that the rejection under 35 U.S.C. § 102 be reconsidered and withdrawn.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Frank R. Cottingham
Attorney for Applicants
Registration No. 50,437

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1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600